

U.S. Patent Application Serial No. 09/763,049
Amendment Under 37 C.F.R. § 1.114 dated April 6, 2007
Reply to Official Action dated April 6, 2006

REMARKS

I. Status of the Claims

Claims 16, 18, 22, and 23 are amended and claims 24-33 are newly added. All amendments and new claims are made without acquiescence to any rejection. These amendments have been made to more particularly describe what Applicants regard as their invention. Support for the new and amended claims can be found in the originally-filed specification, and in particular on pages 6-7 and 10, for example.

Support for the proviso excluding 1,2-octanediol in new claim 32, can be found, for example, in the Trinh et al. Application 08/789,171 incorporated by reference on page 7; the Trinh Application is now U.S. Pat. No. 5,912,408 and 1,2-octanediol can be found, for example, at column 6 lines 47-63. Since the "information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed," no new matter has been added. M.P.E.P. § 2163.07(b).

II. Rejection under 35 U.S.C. § 103(a)

Claims 18-23 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Pat. No. 5,746,776 to Smith et al. ("Smith") in view of U.S. Pat. No. 5,547,476 to Siklosi et al. ("Siklosi") for the reasons set forth on pages 2-4 of the outstanding Office Action.

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To establish a *prima facie* case of obviousness, three basic criteria must be satisfied.

First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art must teach and suggest all the claim limitations. See, e.g., M.P.E.P. § 2143. Here, Applicants respectfully submit that the Examiner has not provided evidence of motivation or that all the limitations have been met.

A. There is no motivation to choose ethylene glycol or a C₃-C₄ diol

The Examiner has provided no motivation to choose ethylene glycol or a C₃-C₄ diol from the plethora of organic solvents or co-solvents listed in Smith. First, the Examiner incorrectly asserts that "the use of a diol or ethylene glycol ... are taught as preferred." Yet, ethylene glycol and C₃-C₄ diol are referred to only once in the entire Smith patent - at column 5 line 58 - and there is no express statement or implied mention that their use is preferred. In fact, in that same section, Smith states that glycol ether is most preferred while other recited preferred solvents include the "di- to tetrachlorinated derivatives of methane, the di- to pentachlorinated derivatives of ethane and of ethylene, the mono- to trichlorinated derivatives of cyclohexane, and monochlorobenzene." Col. 5, ll. 38-39, 62-67. Thus, that the other solvents are preferred while ethylene glycol and C₃-C₄ diol are not, provides a teaching away from choosing ethylene glycol or a C₃-C₄ diol.

Also, Smith provides a list of multiple genus and subgenus that easily exceeds 500 compounds. And it is from this vast number of compounds that the Examiner has chosen ethylene

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glycol or a C₃-C₄ diol. Yet, aside from the Examiner's incorrect statement of Smith's preference, there is no evidence provided to motivate the choice of ethylene glycol or a C₃-C₄ diol. That the Examiner can find the instantly claimed limitations in a prior art is not enough to establish motivation, it is merely an improper hindsight analysis. Using the Applicants' specification as a guide to choose and combine the instantly claimed limitations from the prior art is forbidden in an obviousness analysis. See *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000); M.P.E.P. §2143.01.

The Federal Circuit has specifically required that a convincing line of reasoning must be presented as to why one of ordinary skill in the art would pick and choose various elements and/or concepts from the prior art to arrive at the claimed invention. *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985); *In re Wesslau*, 147 USPQ 391 (Bd. Pat. Pat. & Inter. 1965); M.P.E.P. §2144. Here, the Examiner has not provided sufficient evidence or an adequate line of reasoning to motivate the various choices, individually or simultaneously, from Smith's disclosure to yield the claimed compounds. Accordingly, this rejection is improper. At best, the Examiner provides compounds within the vast genus that would be, *arguendo*, obvious to try, but "obvious to try" is not the standard for an obviousness rejection. *In re O'Farrell*, 853 F.2d 893, 903 (Fed. Cir. 1988); M.P.E.P. §2145 X.B.

B. The discussion of amount of cleaning solution does not provide motivation

The Examiner's discussion of the amount of cleaning solution on the sheet lacks motivation. Specifically, the Examiner states that "one of ordinary skill in the art would be confident in the amount of cleaning composition that should be applied, ... depending on the physical limitations of

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the containment bag and the needs of the consumer" and the extent of fabric soiling. Office Action, bridging paragraph at pp. 3-4. First, this rationale is improper at least because it does not provide motivation for choosing specific ranges of the cleaning composition, but merely provides factors that could be considered to try different sets of variables (i.e., amount of cleaning solution, bag size, etc...). Even if these sets of variables were obvious to try based on the Examiner's discussion, obvious to try is not the standard for an obviousness rejection, as discussed above.

Second, the Examiner may be treating the amount of cleaning solution as a result-effective variable where the result can be optimized by varying the amount of cleaning solution. Under this analysis a "parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation." M.P.E.P. § 2144.05 II. B. citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). According to the Examiner's statement above, these results allegedly include the size of the sheet, the extent of fabric soiling, the size of the container bag, and consumer need. But the size of the sheet and the size of the container bag are themselves variables, not results. Under the result-effective variable analysis, the Examiner must not look only to the cleaning fluid amount (which the Examiner has incorrectly treated as a single variable, as discussed below), but must also consider the size of the dryer sheet and the size of the container bag in evaluating the effects these variables together have on that result. Also, the Examiner has not provided evidence that consumer need is an effect that can be quantified for optimization, and thus consumer need cannot be an effect upon which a variable can be optimized. Thus, at best, only the extent of fabric soiling (i.e., its ability to be cleaned) is a result upon which a variable can be optimized. Finally, Applicants do not concede that the ability to clean soiled fabric is an applicable or strictly quantifiable effect because other factors can change the ability to clean

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soiled fabric for a fixed amount of cleaning solution. These other factors might include, for example, (a) the amount, if any, of a spot cleaning composition used prior to the cleaning, and (b) whether the bag is vapor-venting or vapor-impermeable. The Examiner has not addressed the possible interplay between these factors and the amount of the cleaning solution.

Next, the Examiner's discussion considers only a "cleaning solution." This is inadequate because Applicants' claims require a cleaning/refreshment composition and a fabric shrinkage reducing composition. The fabric shrinkage reducing composition substantially reduces shrinkage of treated garments when used with the cleaning/refreshment composition. Specification, pp. 6. Optimization of only the cleaning/refreshment composition without consideration of the fabric shrinkage reducing composition is incomplete because they work together to provide the reduced shrinkage. The Examiner has not addressed the possible interactions of cleaning/refreshment composition with fabric shrinkage reducing solution.

C. Neither Smith nor Siklosi teach the claim limitations

The Examiner has not provided evidence showing that all the limitations of the claims have been met. For example, no evidence is presented showing that either Smith or Siklosi recite the limitations of

(i) "from about 10 grams to about 30 grams of a liquid cleaning/refreshment composition comprising at least about 80% by weight, of water releasably absorbed in the substrate" or

(ii) "from about 2 grams to about 20 grams of a fabric shrinkage reducing composition comprising a fabric shrinkage reducing agent selected from the group consisting of: ethylene

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glycol, all isomers of propanediol, butanediol, pentanediol, hexanediol and mixtures thereof releasable absorbed in the substrate."

The Office Actions to date do not provide sufficient evidentiary detail to demonstrate that the specifics of these limitations are met. For example, the Office Action does not show how the specific limitations of "from about 10 grams to about 30 grams of a liquid cleaning/refreshment composition" and "from about 2 grams to about 20 grams of a fabric shrinkage reducing composition" are met. Indeed, Applicants contend that they are not found in Smith or Siklosi.

Accordingly, Applicants respectfully request that the rejection of Smith in view of Siklosi should be withdrawn.

III. New Claims 32 and 33

Applicants submit that new claims 32 and 33 are allowable for the reasons provided above to traverse the extant obviousness rejection and also for the reasons discussed specifically below.

New claim 32 excludes 1,2-octanediol from the sheet, whereas Siklosi requires 1,2-octanediol. Abstract; col. 2, ll. 19-26; col. 3, ll. 63-65; Examples 1-3; claim 1. Because Siklosi cannot be combined with other prior art without including 1,2-octanediol, the exclusion of 1,2-octanediol, at least, makes claim 32 allowable over any combinations with Siklosi. As such, Applicants respectfully submit that claim 32 is allowable.

Claim 33 requires the sheet be designed for use in a vapor-venting bag having the indicated VVE scoring range. The design considerations for sheets used in a vented bag are

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considerably different compared to those used in a vapor-impermeable bag, as discussed at page 10 of Applicants' instant specification. Siklosi and Smith use vapor-impermeable bags, and their teachings cannot be used to achieve a sheet that would perform in a vapor-vented bag. Thus, Applicants respectfully submit that claim 33 is allowable.

IV. Conclusion

If the Examiner wishes to discuss any aspect of the prosecution of this application, he is invited to contact the undersigned at (513) 977-8253.

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Respectfully submitted,

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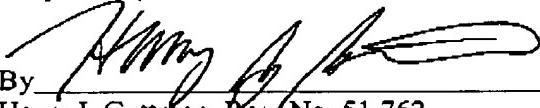
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